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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,090	06/07/2001	Mark Andrew Benny	AUS9-2001-0209-US1	9388

7590 07/27/2006

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EXAMINER	
OSMAN, RAMY M	

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/876,090	BENNY ET AL.	
	Examiner	Art Unit	
	Ramy M. Osman	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This communication is responsive to appeal brief filed May 2, 2006. Claims 22-25 are pending.

Response to Arguments

2. Applicant's arguments, filed 5/2/2006, with respect to the rejection(s) of claim(s) 22-25 under 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hill et al (Patent No 6,670,973).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 22-24 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. ***MPEP Section 2106(IV)(B)(2)(B)(ii)*** mentions that a statutory computer process is determined not by how the computer performs the process, but by what actions the computer performs to achieve a practical application with a useful, concrete and tangible result. Independent claims 22 and 23 are non-statutory because they do not claim a practical application with a tangible result. Independent claim 24 is non-statutory because applicant is claiming an intangible software program ***(see MPEP Section 2106(IV)(B)(2)(C))***.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/875,863.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, while the pending application is directed to a method for designing an enterprise service delivery technical framework for a customer. Furthermore, both applications are directed to concepts for determining a solution scope, mapping existing customer information

to architectural building blocks of a service delivery technical model, and designating relationships between design objects as a function of the solution scope.

For at least these reasons, it would have been obvious for one of ordinary skill in the art that the concepts for creating a technical framework for use in delivering a specific set of information technology services for a customer, and designing an enterprise service delivery technical framework for a customer of the present invention as in the application, are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

7. Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-30 of copending Application No. 09/875,865.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, while the pending application is directed to a method for using an enterprise service delivery technical model to develop a technical framework to provide System Management services to a customer. Furthermore, both applications are directed to concepts for determining a solution scope, mapping existing customer information to architectural building blocks of a service delivery technical model, and designating relationships between design objects as a function of the solution scope.

For at least these reasons, it would have been obvious for one of ordinary skill in the art that the concepts for creating a technical framework for use in delivering a specific set of information technology services for a customer, and designing an enterprise service delivery technical framework for a customer of the present invention as in the application, are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 22-25 rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al (US Patent No 6,670,973).

Hill teaches a method, a technical framework, a computer readable medium comprising a program, and a data processing system all correspondingly and operable to deliver a specific set of information technology services for a customer, comprising the steps of:

determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contact with the customer, the solution scope based on common practices for delivering certain types of information technology services (see at least, column 1 line 53 – column 2 line 10 and column 3 lines 10-65);

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities (see at least column 4 lines 35-55, column 6 line 64 – column 7 line 10 and column 9 lines 1-55);

creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components (see at least column 3 line 34 – column 4 line 35 and column 9 lines 1-55); and

designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer (see at least column 4 lines 1-7).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Patent No US006091893A, Fintel et al teaches a method of building an IT architecture visual model.

Patent No US006442557B1, Buteau et al teaches an enterprise architecture model including relational database.

Patent No US006983321B2, Trinon et al teaches managing impact of IT infrastructure situations on business services.

Moser et al, "Modeling the information systems architecture", teaches modeling information requirements of an enterprise, mapping the information needs of an organization, and relating them to specific processes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO
July 21, 2006

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